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EXAMINER

WOO, STELLA L

ART UNIT PAPER NUMBER

2643

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/483,277

Applicant(s)

KATZ, RONALD A.

Examiner

Stella L. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47-50 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-50, 52-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims are 47-49 rejected under 35 U.S.C. 103(a) as being unpatentable over Barger et al. (US 4,071,698, hereinafter "Barger") in view of Gordon et al. (US 4,763,191, hereinafter "Gordon").

Barger discloses a method for controlling voice-data communications, comprising the steps of:

cuing select remote terminal (audio program repeater prompts the push-button caller to enter responses; col. 6, lines 38-43; col. 11, lines 18-23);

selectively identifying said responsive signals as digital data signals (a push-button caller can enter an account number, credit card number, selection number; Figs. 4 and 6; col. 4, line 64; col. 8, lines 60-65; col. 9, lines 40-42; col. 11, lines 18-25) or digital control signals (a push-button caller can key in a specific code for operator assistance; col. 9, lines 38-40), or both (an invalid account number entered by the caller causes the call to be transferred to an operator for assistance; col. 9, lines 40-45), said responsive signals including signals indicative of a customer card number (credit card number can be used as an account number; col. 2, lines 55-57; col. 4, lines 63-64; col. 8, lines 60-65);

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testing (credit verification takes place based on the credit card number; col. 8, lines 60-65);

transferring a call to an attended terminal (callers whose credit cannot be validated or those determined to be freeloaders or those who key in a specified code requesting operator assistance are automatically connected with an attended terminal 39; col. 9, lines 42-45; col. 11, lines 34-36; col. 9, lines 38-40) and displaying (operator's terminal displays all the data for the customer's call including any historical and credit verification data retrieved from memory; col. 5, lines 29-37; col. 6, lines 3-9, 21-29).

Barger differs from the claims in that it does not specify receiving and recording caller number identification signals. However, Gordon teaches the well known use of caller number identification signals in a telephone ordering system for identifying callers and recording the caller number identifications signals for compiling the necessary delivery and charging information (col. 2, lines 48-64) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of caller identification signals, as taught by Gordon, within the ordering system of Barger to provide additional identifying data for use in compiling the necessary delivery and charging information.

3. Claims 50, 52-53, 56-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruyn in view of Szlam et al. (US 4,797,911, hereinafter "Szlam").

DeBruyn discloses a method for controlling voice-data communications for use with a communication facility (telephone exchange 3) including remote terminals (telephone sets 1), the method comprising the steps of:

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interfacing a call from said individual caller to the automated system (after the subscriber selects the telephone number which has been awarded to the Lotto game, he is automatically connected to the Lotto computer device (page 4, lines 14-23);

receiving data entered by said individual caller including two forms of distinct identification data (subscriber's telephone number and an associated secret code is received; page 1, line 28; page 3, line 28; page 6, line 28 – page 7, line 2);

testing at least certain of said data to determine if the individual caller is calling for a first time or with respect to a limit on use with respect to each individual caller (converting and confirming apparatus 11 determines whether the phone number of the caller has already been recorded for the current Lotto game; page 5, lines 11-21; page 3, line 28 – page 4, line 5);

prompting said individual caller via a voice generator to enter additional data (reply apparatus 8 prompts a caller to enter a Lotto number; page 3, lines 24-26; page 4, line 28 – page 5, line 6).

DeBruyn differs from claims 50, 52-53, 56-60 in that it does not specify that the caller's telephone number is received as data entered by the caller. However, Szlam teaches the desirability of receiving a caller's telephone number by prompting the caller to key in this telephone number (col. 13, lines 18-20) in the event ANI is not available (col. 13, lines 1-2) such that it would have been obvious to an artisan of ordinary skill to incorporate such prompting and receiving of a telephone number from the caller, as taught by Szlam, within the method of DeBruyn in order to accommodate callers from locations in which ANI is not available.

DeBruyn further differs from claims 50, 52-53, 56-60 in that it does not provide for the steps of transferring the call to an attended terminal and displaying at the attended terminal at

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least a portion of the entered data. However, Szlam teaches the desirability of transferring a call to an operator terminal (col. 12, lines 9-66), in which both data entered by the caller (telephone number or account number; col. 13, lines 18-22) and data stored for the caller (customer account information previously stored in the mainframe 16; col. 12, lines 39-42) is displayed upon the screen of the operator terminal (col. 13, lines 22-29). It would have been obvious to an artisan of ordinary skill to incorporate such use of an operator terminal, as taught by Szlam, within the method of DeBruyn in order to provide human assistance as well as to collect more detailed information regarding the caller.

Regarding claim 52, in DeBruyn, each caller is limited to a permitted number of stakes per week (page 3, line 28 – page 4, line 2).

Regarding claim 53, DeBruyn provides for a plurality of format configurations (several groups of electronic apparatus assembled in the same manner, each group of which is intended for the processing of a specific language and connected to the same central computer 4; page 3, lines 7-16).

Regarding claims 56-59, Szlam provides for recording audio signals via a message recorder for later playback to an operator terminal (col. 17, lines 27-46), in which the messages can be in analog or digital form (col. 17, lines 32-34).

Regarding claim 60, Szlam provides for displaying the caller's telephone number at the attended terminal (system controller 11 collects the telephone number keyed in by the caller and sends the information collected to the operator terminal for display upon the screen; col. 13, lines 18-25).

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4. Claims 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruyn in view of Szlam, as applied to claim 50 above, and further in view of Entenmann et al. (US 4,996,705, hereinafter "Entenmann").

The combination of DeBruyn and Szlam differs from claims 54-55 in that it does not specify receiving caller credit card number data. Rather, in DeBruyn, the lottery participation charges are billed to the caller's telephone account (page 6, lines 24-27). However, Entenmann teaches the well known use of a credit card account to pay for participating in a lottery (col. 2, lines 63-65) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of credit card payment, as taught by Entenmann, within the combination of DeBruyn and Szlam in order to provide a caller with an another payment option.

5. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBruyn, Szlam, and Entenmann, as applied to claims 54-55 above, and further in view of Stephenson, Jr. et al. (US 3,727,186, hereinafter "Stephenson").

The combination of DeBruyn, Szlam and Entenmann differs from claim 61 in that although it does teach credit card authorization (Entenmann, col. 2, lines 63-65), it does not specify testing for negative file data. However, Stephenson teaches that it is old and well known in the credit authorization art to test for negative file data (warning file 30) when determining whether or not a credit card number is authorized (col. 5, lines 22-28; col. 6, lines 30-37) such that it would have been obvious to an artisan of ordinary skill to test for negative file data, as taught by Stephenson, within the combination of DeBruyn, Szlam and Entenmann so that credit card number can be more quickly verified by checking against a warning file of unauthorized credit card numbers.

***Response to Arguments***

6. Applicant's arguments filed June 14, 2004 have been fully considered but they are not persuasive.

In the remarks section of the Amendment filed June 14, 2004, Applicant states that the claims pending presently in the case are 47-61. However, on page 4, claim 51 is identified as being canceled. Therefore, the claims pending are claims 47-50, 52-61.

Regarding the rejection of claims 50-61 under 35 USC 112, 1<sup>st</sup> paragraph, Applicant points to the specification at page 14, paragraph 1. However, in the Amendment filed June 14, 2004, Applicant amended claim 50 by deleting the subject matter which was considered by the examiner as lacking support in the specification, that is, "testing...to determine if a caller's status reflects *an outdated record*." Therefore, the rejection of claims 50, 52-61 under 35 USC 112, 1<sup>st</sup> paragraph no longer applies. Contrary to applicant's assertion that claim 50 has been cosmetically amended, it appears that claim 50 has been amended in response to the rejection of claim 50 under 35 USC 112, 1<sup>st</sup> paragraph because a "limit on use with respect to each individual caller" is not an equivalent or a cosmetic alteration of "an outdated record."

Regarding the rejection of claims 47-49 under 35 USC 103 over Barger in view of Gordon, Applicant argues that "the patent to Gordon, et al. involves taking the ANI data simply to identify the caller account" and "[o]nly if the ANI data is not available, does a transfer to an operator occur." However, the rejection of claims 47-49 relied upon Barger, not Gordon, for its teaching of transferring a call to an attended terminal. In Barger, callers whose credit cannot be validated *or* those determined to be freeloaders *or* those who key in a specified code requesting



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operator assistance are automatically connected with an attended terminal 39 (col. 9, lines 42-45; col. 11, lines 34-36; col. 9, lines 38-40).

### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

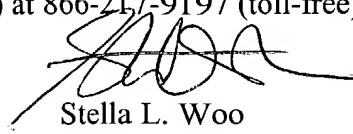
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (703) 305-4395. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stella L. Woo  
Primary Examiner  
Art Unit 2643